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| 09/805,510      | 03/13/2001  | Hans-Peter Weitzel   | U-Wp-5577 Wacker    | 1883             |

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06/24/2003

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

15

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,510

Applicant(s)

WEITZEL, HANS-PETER

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/24/03;04/21/03.
- 2a) ☐ This action is FINAL.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_      6) ☐ Other:

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**DETAILED ACTION**

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/21/03 has been entered.

**Claim Rejections - 35 USC § 112**

2. Claim 21-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no express support can be found for the recited "protective colloid is a partially hydrolyzed polyvinyl alcohol having a degree of hydrolysis less than 95 mol percent" per claim 21 and, as such and without any guidelines from applicant as to where support might be found, this engenders a New Matter situation. Reference page 8 wherein the degree of hydrolysis of the partially hydrolyzed polyvinyl alcohol(s) referenced is "from 80 to 95 mol%".

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

4. Claims 21-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "from 5 to 80 weight percent cement, from 5 to 80 weight percent of filler, and from 0.5 to 60 weight percent of protective colloid stabilized polymer powder" per claim 21 constitutes indefinite subject matter as per the entity that the contents are being based on is not readily ascertainable, i.e., total construction adhesive or else.

B) The recited "partially hydrolyzed polyvinyl alcohols" per claim 28 constitutes indefinite subject matter as per it not being readily ascertainable as to how protective colloid, in terms of degree of hydrolysis, further limits the antecedently recited protective colloid.

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C) The recited "partially hydrolyzed polyvinyl alcohols having a degree of hydrolysis of from 80 to 95 mol %" per claim 29 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited "partially hydrolyzed polyvinyl alcohol having a degree of hydrolysis less than 95 mol percent".

**Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

6. Claims 21-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Geissler(U.S. 6,331,587).

Geissler discloses a process for the preparation of vinyl ester polymer dispersions which are stabilized with protective colloids and have a high solids content, to the so-prepared dispersions, and to the use of these dispersions, or of the dispersible dispersion powders obtained therefrom by spray drying, for example, for modifying building materials. More specifically, Geissler et al teach processes for the preparation of dispersions which comprise a copolymer of vinyl ester and further monomer(s) copolymerizable with the vinyl ester stabilized with a protective colloid, viz., 2 to 15 wt.% of a polyvinyl alcohol governed by a degree of hydrolysis of 80 to 99 mol%, preferably, 88 mol % wherein the further monomer can include up to 50 wt.% of monomers which include ethylene, esters of (meth)acrylic acid and up to 5 wt.%, preferably 0.1 to 5% by weight, based on the total amount of monomers employed, of monoolefinically unsaturated monocarboxylic and dicarboxylic acids such as(meth)acrylic acid, etc.

Geissler teaches @ col. 4, lines 7-24, that the dispersions prepared according to the invention can be employed as for modifying building materials, for example tile adhesives, composite thermal insulation adhesive and filling compositions, plasters and repair mortars and that plastics powders which are very readily redispersible can be prepared by methods known per se, for example, by spray drying from the dispersions prepared according to the

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*invention. Such plastics powders can likewise be employed in hydraulically setting building materials and in colored powder coatings. More specifically, Geissler teaches the use of the polyvinyl ester dispersions as binders in building materials and for the preparation of redispersible dispersion powders, preferably for use in building materials and colored powder coatings. Geissler at col. 8, lines 13-50, teaches that the spray dried dispersions(powders) of the previous Runs(7, 12 and 14), in combination with an anticaking agent in an amount of 12 wt.%(talc + dolomite) and cement, in an amount falling within the scope of the claims, are used in hydraulically setting building materials. Geissler therefore anticipates the instantly claimed invention.*

*As to the introductory phrase "A process for improving the tensile strength of a set cementitious or cement free, inorganic binder-based construction adhesive" per claim 37, such cannot serve to patentably distinguish the claimed method from that of Geissler. That language, in effect, is the result of combining a protective-colloid stabilized aqueous polymer dispersion or redispersible polymer powder therefrom and a cementitious or cement-free, inorganic binder-based construction adhesive. While the prior art does not show a specific recognition of that result, its discovery by applicants is tantamount only to finding a new use for an otherwise old composition(reference in re Tomlinson, 150 USPQ 623).*

*As to the dependent claims, the limitations are either taught by Geissler, suggested by Geissler or would have been obvious to the skilled artisan and with a reasonable expectation of success.*

#### **Response to Arguments**

7. *Applicant's arguments filed 02/24/03 and 04/21/03 have been fully considered but they are not persuasive.*

*Relative to Geissler*— *The crux of Counsel's arguments appears to hinge on a) the "water resistance" property not being recognized by Geissler and b) the optional comonomers such as the mono- and dicarboxylic acids disclosed as being operable in amounts of preferably 0.1 to 5 weight percent, not being exemplified.*

*Relative to item a)*— *When the claimed compositions are not novel they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in the prior art, i.e., when a claimed product appears to be substantially the same as a product disclosed in the prior art, the burden of proof is on the applicants to prove that the prior art product does not inherently or necessarily possess the characteristics attributed to the claimed product(In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658(Fed. Cir. 1990)).*

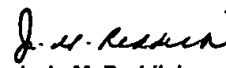
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Relative to item b)— Counsel is reminded that a reference is evaluated, as a whole, for what it fairly teaches and in noway limited to the working Examples, i.e., the specification need not contain an example if the invention is otherwise disclosed in such a manner that one skilled in the art will be able to practice it without an undue amount of experimentation. (In re Borkowski, 422 F. 2d 904, 908, 164 USPQ 642, 645 (CCPA 1970)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR Jma  
June 19, 2003